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Remarks

Claims 1 through 7, 9 through 16 and 18 through 27 remain pending in the application.

The Office Action rejects claims 1 through 7, 9 through 16 and 18 through 27 as obvious over Porcher, Ski Boot, U.S. Patent 4,702,022 (Oct. 27, 1987) in view of Dalvy et al., Internal Liner for a Boot, U.S. Patent 5,924,218 (Jul. 20, 1999) in view of Mashita et al., Footwear Member, U.S. Patent 5,681,649 (Oct. 28, 1997) under the assertion that Porcher discloses all the limitations, including a liner with multiple resilient layers; that Dalvy teaches a gel pad located between the layers of an inner boot; that Mashita teaches that a gel pad of styrene and butadiene can be located in the toe box area; and that it would have been obvious to place a gel pad in the toe box area as taught by Mashita and to place a pad in the heel area of the liner of Porcher to aid in protection and comfort of the user's foot. With respect to the different hardnesses of the toe box and heel counter, the Office Action asserts that it would have been a mere matter of testing and optimization to find a combination of material that would provide the desired comfort and protection that would meet the desired total hardness of different areas of the boot.

With regard to claims 1 through 7, 9 through 16 and 18 through 22, the Office Action has failed to state prima facie obviousness rejections because the proposed combination does not result in the claimed inventions. The proposed combination does not provide for, and cannot provide for, the location of the pads in the toe box and heel counter areas as claimed. The Office Action asserts that Mashita teaches that Mashita's pad may be placed "anywhere" within the shoe. Mashita's vague and overly broad statement adds nothing to the other two references regarding

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specifically where Mashita's pad may be placed. Thus, one of ordinary skill must still modify the combination of Porcher, Dalvy and Mashita to achieve the limitations of claims 1 through 7, 9 through 16 and 18 through 22 regarding the placement of pads in the toe box or heel counter areas of the claimed boots. Accordingly, the Office Action has failed to state prima facie obviousness rejections of claims 1 through 7, 9 through 16 and 18 through 22.

In its response to arguments the Office Action states that Mashita "teaches that the pad can be placed wherever necessary to aid in cushioning the impact to a user's foot...therefore, wherever the pad would contribute to cushioning the impact of the user's foot, either within the lining, between other pads, etc., it would have been obvious...to place the pad wherever necessary." This statement does not relieve the examiner of the burden of fashioning prima facie obviousness rejections. An overly broad assertion that a pad may be located "wherever necessary" does not provide sufficient disclosure to enable one of ordinary skill to design the claimed boots. The proposed combination, which only relies on the cited references, must therefore be further modified to achieve the claimed boots. Accordingly, the Office Action has failed to state prima facie obviousness rejections of claims 1 through 7, 9 through 16 and 18 through 22.

Regarding claims 2 and 10, the Office Action improperly rejects the limitation that the pad comprises a mixture of styrene and 1,3-butadiene. Mashita does not show or suggest the use of 1,3-butadiene and does not show or suggest the combination of styrene and 1,3-butadiene. Given the vast number of combinations shown by Mashita, there is no reason why one of ordinary skill would select a particular combination shown in Mashita, much less a combination that is not shown in Mashita. Thus, the Office Action has failed to state prima facie obviousness rejections of claims 2 and 10.

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Regarding claims 3, 4, 11, 12, 22 and 27, the Office Action statement that the different durometer values of certain areas of a boot would have been a mere matter of testing and optimization is incorrect. The Office Action response statement that a person of ordinary skill would be able to determine what material and how much material to use to prevent a predicted compression is also incorrect, as indicated in the references themselves. As pointed out in the last Office Action response, Mashita goes to great lengths to place limits on the ratios of the mixture of materials for his pad. He states that,

The medium material is a material having a function as a medium between the low molecular weight and the high molecular weight or polymer material. *It is a key material in achieving the object of the present invention.*

Mashita, column 3, lines 27 through 30 (emphasis added). The emphasized sentence shows that selecting the exact material used is difficult and requires extraordinary skill. Furthermore, given the numerous possible combinations of pad materials to select from, the natural conclusion is that making a pad (much less a boot) having a particular hardness is a difficult task. Indeed, Mashita obtained a patent on his pad material, proving that it takes extraordinary skill to make a pad or a boot having a particular hardness.

Dalvy also shows that making a boot with a particular hardness is not a matter of mere testing. Dalvy states that,

It is known to vary the density of these foams: a high density providing a high resistance to crushing but a lesser comfort since it is less flexible and less compressible, and conversely, a low density providing a low resistance to crushing but an increased comfort due to the flexibility and substantial compressibility of the foam. The

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comfort/duration optimum compromise over time is therefore very difficult to achieve.

Dalvy, column 2, lines 7 through 13 (emphasis added). The emphasized sentence directly supports the fact that making a boot having a particular hardness is very difficult to achieve. Because both Dalvy and Mashita indicate that making a boot having a particular hardness is very difficult, requiring extraordinary skill, claims 3, 4, 11, 12, 22 and 27 are non-obvious.

Furthermore, even if Dalvy and Mashita had remained silent on the issue of the difficulty of boot design and manufacturing, the Office Action has misapplied the obviousness statute. As discussed in the last Office Action response, the statute specifically provides that "...patentability shall not be negated by the manner in which the invention was made." 35 U.S.C. § 103(a). By statutory definition, the process of testing and optimization are irrelevant to an obviousness inquiry. Thus, even if Applicant discovered the claimed inventions by experimentation, the claimed inventions are still non-obvious. The "mere" act of "testing and optimization" does not render the claimed subject matter obvious because "testing and optimization" can lead to a non-obvious invention. Thus, the Office Action has failed to state prima facie obviousness rejections with respect to claims 3, 4, 11, 12, 22 and 27.

With respect to all of the claims, the Office Action has yet to suggest a specific motivation to combine the references in the manner proposed. The Office action has stated in its response to arguments that, "all of the references include the idea of improving cushioning of a user's foot within a shoe." However, this statement is too broad to serve as a motivation to combine the references in the manner proposed. At most this statement indicates an overarching concern in the art of shoe making. If this statement could serve a motivation to modify or combine prior art references, then few shoe patents would issue. (It would be

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obvious to modify many shoe patents because many inventions in the art of shoe making are directed to making a shoe more comfortable). However, since 1976 alone over 24,000 patents have issued that contain claim limitations to a shoe or boot. If an overarching concern in the art of shoe making would render obvious any comfort-improving invention, then such a plethora of shoe patents simply would not exist. Thus, the Office Action statement is too broad to serve as a specific motivation to combine the references. Accordingly, the Office Action has failed to state prima facie obviousness rejections.

In its response to arguments the Office Action also states that "Mashita teaches that the pad can be placed wherever necessary to aid in cushioning the impact to a user's foot...therefore, wherever the pad would contribute to cushioning the impact of the user's foot, either within the lining, between other pads, etc., it would have been obvious...to place the pad wherever necessary." However, this statement is too broad to serve as a motivation to combine the references. Boot designers are keenly interested in the precise location of any object incorporated into a boot. Care is taken to design the exact size, shape and hardness of all components of the boot. Thus, one of ordinary skill would read the Mashita statement in the light of the prior art in deciding where to locate his pads. However, no one has suggested placing pads in the toe box and heel counter areas of a boot as claimed. Thus, one of ordinary skill would not be lead by Mashita's disclosure to design the claimed boots. Accordingly, the claims are non-obvious.

Moreover, no one would place the pad just anywhere within a shoe, particularly given the costs associated with manufacturing a shoe that fails in the market due to a lack of comfort or to a lack of utility caused by a misplaced pad. Instead, one of ordinary skill in the art would, at best, think to place the Mashita pad in places where other prior art references teach a pad

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should be placed in a shoe. No known references teach placing a pad in the toe box or heel counter areas of a boot as claimed. Thus, upon reading Mashita one of ordinary skill would not think to place a pad in the toe box or heel counter areas of a boot as claimed. Accordingly, the claims are non-obvious.

If the Examiner believes that the term "wherever necessary" would lead one of ordinary skill to place a pad in the toe box or heel counter area as claimed, then Applicant points out that thousands of shoe designers have failed to do so over the intervening years since Mashita issued. This failure proves that the Examiner's overly broad statements are insufficient motivation to combine the references. Because no motivation exists to modify the combination of the references, claims 1 through 7, 9 through 16 and 18 through 22 are non-obvious.

In addition, there is no motivation to combine or modify the references because Dalvy, Mashita and Porcher each represent a complete solution to the problems each addresses. Porcher shows a boot that self-closes and he seeks a solution to the problem of closing ski boots. Dalvy shows a boot with a thermoplastic wedging element and seeks a solution to the problem of how to form-fit boots to a wearer and to do so without requiring constant re-treatments of heat to the wedging element. Mashita shows a gel pad for use inside shoes or boots and seeks to solve the problem of how to make a gel pad having "superior" cushioning properties. Because each reference represents a complete solution to the distinct problems each reference solves, there is no motivation for one of ordinary skill to substitute parts of one reference for parts in any other reference. Thus, there is no motivation to combine the references and so the claims are non-obvious.

In its response to arguments, the Office Action states that direct statements regarding whether one reference would benefit from another are not required and that the benefit of better cushioning to the user's foot is at least part of a problem to be

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solved by all three references, either inherently or explicitly. The Office Action misunderstands Applicant's argument. Because the references represent complete solutions to the problems they address, there is no motivation present in the references to combine the references. As explained above, the "benefit of better cushioning" is an insufficient motivation to combine the references because the idea of "better cushioning" is overly broad. Because the references represent complete solutions to the problems they solve, there is no express or implied connecting theme to guide one of ordinary skill to combine the references in the manner proposed. Accordingly, the claims are non-obvious.

In addition, the claims are not obvious because if the claims had been obvious, then those of ordinary skill in the art would have already made the claimed shoes or boots. In the last century, billions of shoes and boots designed to protect a wearer's foot from impact have been sold, generating many billions of dollars in revenue. More recently, Porcher issued in 1987, Dalvy issued in 1999 and Mashita issued in 1997. In the intervening years between 1999 and 2001, or even between 1999 and now, to Applicant's knowledge no one of any skill level has suggested the claimed limitations except for the Applicant and the Examiner. Given the utility of the claimed invention, the size of the shoe market, the age of the references and the business opportunity generated by the claimed shoes, someone in the world would have produced a product or published a reference that shows all of the limitations of the claimed inventions had the claims been obvious. Because no one has done so, the claimed inventions are non-obvious.

The Office Action supports its assertion of obviousness by stating "It is well known throughout the art of making boots that certain areas of impact of the user's foot with the ground would need more cushioning..." If this fact were well known, then one would think that the claimed inventions would have been produced

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or at least shown in the prior art (without the need for an ad hoc modification proposed by the examiner). Because the claimed inventions have not been shown or produced in the prior art, the Office Action statement supports the fact that the claimed inventions are non-obvious.

Given the lack of specific disclosure in the references, either explicit or implied, regarding the placement of pads within shoes as claimed, the Examiner must have gleaned the idea of placing the pads in a boot as claimed from Applicants' own disclosure. Thus, the Examiner appears to have used impermissible hindsight in fashioning the obviousness rejections.

In addition, the fact that the claimed footwear has not been shown in the prior art, despite intense competition in the footwear business, also supports the conclusion that the Examiner has used impermissible hindsight to combine the references. To date, and to Applicant's knowledge, only the Applicant and the Examiner have suggested the proposed combination. Because so many others of skill in the art have failed to propose the claimed combination, and because the Examiner proposed the combination only after reviewing Applicant's disclosure, the Examiner seems to have used impermissible hindsight to combine the references. Accordingly, the Office Action has failed to state prima facie obviousness rejections.

In addition, the claimed inventions are non-obvious because the claimed inventions have enjoyed outstanding commercial success. To show that the claims are non-obvious, evidence of commercial success must establish a nexus between the claimed inventions and the commercial success. In re Huang, 100 F.3d 135 (Fed. Cir. 1996). The following facts, supported by a declaration by the Vice President of Footwear of DC Shoes, Inc., Jeffery McCall, show the nexus between the boots having pads disposed as claimed and the commercial success of the claimed boots.

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In just the first year of production (2003) DC Shoes, Inc., the assignee of this application, sold 32,700 boots containing a toe pad and a heel pad as claimed, representing about 6.5% of the worldwide branded snow boot market and approximately 57% of all snow boot sales by DC Shoes, Inc (which sold 57,500 pairs of branded snow boots in 2003). In contrast, in 2002 DC Shoes, Inc. sold 47,000 pairs of all kinds of branded snow boots. DC Shoes, Inc. predicted that 17,000 pairs of the claimed boots would be sold in 2003, though nearly twice that many boots were actually sold in 2003 (32,700). In 2003 DC Shoes, Inc. claimed 10% of the total worldwide branded snow boot market, but in 2002 DC Shoes, Inc. claimed only 5.8% of the total worldwide branded snow boot market.

Because DC Shoes, Inc. marketed the claimed boots to the same degree as any other new boot product, the commercial success of the claimed boots must flow from some advantage inherent in the claimed boots. Because the significant difference between prior boots sold by DC Shoes, Inc. and the claimed boots is the inclusion of a pad disposed in the toe box or heel counter area as claimed, the cause of the dramatic commercial success must be the inclusion of the pads disposed as claimed.

Furthermore, the claimed boots have enjoyed more sales in the first year than any other similar product introduced by DC Shoes, Inc, in the last 6 years despite the fact that the claimed boots were marketed to the same degree as all other previous new boot models. Thus, again, the commercial success of the claimed boots must flow from the claimed features.

Moreover, the claimed boots have a wholesale price of \$90 per pair of boots. Other DC Shoes, Inc. boots have an average wholesale price of \$80 per pair of boots. Given that the claimed boots are marketed to the same degree as other new DC Shoes, Inc. boots, the reason that customers would pay more for the claimed boots is because the claimed boots offer some advantage. The

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significant difference between the claimed boots and other DC Shoes, Inc. boots is the presence of the pads as claimed. Thus, the commercial success of the claimed boots must derive from the claimed features.

DC Shoes, Inc. has also received anecdotes that the reason why the claimed shoes have enjoyed commercial success is due to the placement of pads in the boots as claimed. Moreover, DC Shoes has received anecdotes that professional boot testers found the claimed boots more comfortable during use than other models of branded snow boots due to the placement of the pads as claimed. (A formal survey regarding the reasons why consumers purchased the boots will not be available until later in 2004.) The sales evidence already provided supports and makes credible the anecdotes received by DC Shoes, Inc. In the light of all of the other evidence presented by the Applicant, the natural conclusion to draw is that there is a nexus between the claimed inventions and the commercial success.

Even so, for evidence of commercial success to overcome a finding of obviousness, the marketed boots must also be commensurate with the scope of the claims. In re Tiffin, 448 F.2d 791 (C.C.P.A. 1971). The claims are directed to boots having pads disposed in the toe box and heel counter areas of the boots as claimed. DC Shoes, Inc. is selling boots having exactly these claimed features. Thus, the marketed boots are commensurate with the scope of the claims. Therefore, given that the above facts establish a nexus between the claimed inventions and the evidence of commercial success, and given that the success flows from the functions and advantages disclosed in the specification, the evidence of the commercial success of the claimed boots overcomes any obviousness rejection. Accordingly, the claims are non-obvious.

In addition, the art of shoe making is crowded. As previously mentioned, over 24,000 patents contain the term shoe or

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boot in the claims. Given the vast number of kinds of shoes or boots, even a small advance should be considered significant. Because the claimed inventions represent a great advance in the crowded art of shoe and boot design, the claims are non-obvious.

Conclusion

This response has addressed all of the Examiner's grounds for rejection. The rejections based on prior art have been traversed. Reconsideration of the rejections and allowance of the claims is requested.

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